

870, 20 USPQ 2d 1392 (Fed. Cir. 1991). In view of the foregoing, the obviousness-type double patenting rejection should be withdrawn.

The specification has been objected to because the abstract contains more than 150 words. The new abstract provided complies with the length and word count requirements. In view of the foregoing, the objection to the specification should be withdrawn.

Claims 1, 4-19, 34, and 85 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, for an alleged indefiniteness. Applicants respectfully traverse this rejection. The Office Action states that claims 1, 34, and 85 recite that the erasable colored pencil lead is essentially free of low melting waxes or waxy materials having a melting point or softening point of about 90°C or below. The Office Action contends that the scope of the claims is confusing. The Office Action states that it is not clear what the difference is between low melting waxes and waxy materials having a melting or softening point of about 90°C or less. Applicants respectfully submit that the meaning or scope of the term "low melting waxes or waxy materials having a melting or softening point of about 90°C or less" is clear to those of ordinary skill in the art in view of the disclosure. See, for example, page 6, lines 7-16, of the specification. Thus, for example, low melting wax or waxy material can be a material that adheres to and resists removal from paper fibers. The low melting wax or waxy material has a melting point below about 90°C. Further, claims 11-19 have been cancelled.

In view of the foregoing, the indefiniteness rejection should be withdrawn.

#### Discussion of Anticipation Rejection

Claims 22, 34-35, 40-41, 73, 85, and 90-91 are rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent 5,595,589 (Hoshiba et al.). Applicants respectfully traverse this rejection.

The Office Action admits that there is no explicit disclosure that the pencil lead of Hoshiba et al. forms a cohesive layer. However, the Office Action contends that Hoshiba et al. discloses a color pencil lead that is erasable, and therefore, concludes that the pencil lead must inherently form a cohesive layer. The Office Action's conclusion is misplaced. Applicants believe that there is insufficient reasoning to support a *prima facie* determination of the alleged inherent characteristic. The law requires that the reasoning should show that the alleged inherent characteristic must necessarily flow from the teaching of the prior art. The Office Action must clearly identify how the alleged inherent characteristic necessarily flows from Hoshiba et al. The Patent Office must make clear that the missing descriptive matter (here the alleged ability to form a cohesive layer) is necessarily present in the reference, and that it would be so recognized by persons of ordinary skill in the art (see, e.g., *Continental Can Co. v. Monsanto Co.*, 948 F.2d

1264, 20 USPQ 2d 1746 (Fed. Cir. 1991). The Office Action has failed to meet its burden. The recited property does not flow undeniably and irrefutably from the disclosure of Hoshiba et al.

Further, applicants have conducted tests on Hoshiba et al.'s composition and find that the composition does not form an erasable colored-pencil lead. Applicants intend to provide a Rule 132 Declaration shortly.

In view of the foregoing, the anticipation rejection should be withdrawn.

#### Discussion of Obviousness Rejections

1. Claims 22-24, 33, 35-41, 69-75, 84, 86 and 90-91

These claims are rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over JP 02036281 in view of U.S. Patent 5,716,434 (Koyama). Applicants respectfully traverse this rejection.

The Office Action states that the only difference between JP '281 and the presently claimed invention is the requirement in the claims of antioxidant. This is erroneous. Claims 22-24, 35-41, 69-75, 86, and 90-91 do not require that an antioxidant be present in the erasable lead composition.

Further, JP '281 and Koyama, either alone or in combination, fail to suggest to those of ordinary skill in the art the presently claimed invention. JP '281 fails to disclose or suggest a composition capable of making a mark that forms a cohesive layer on the surface of the substrate. JP '281 discloses, at Application Example 1, page 3 of the translation, the use of a 135°F (57.2°C) paraffin wax. The composition of JP '281 is not capable of forming a cohesive layer when marked on a surface. JP '281 states that "a layered application is possible" with its colored pencil lead against "so that the paper of the writing is not smudged" (page 2, second line from the bottom of the translation, and page 3 just above Application Examples). The term "layered application" refers to repeated or overlapping application of the lead to build layers, i.e., writing over and over in the same spot to make a strong mark. This term does not refer to a cohesive layer. In view of the foregoing, JP '281 does not disclose or suggest a cohesive layer. The composition of the presently claimed invention, in contrast, forms a cohesive layer (see, e.g., Examples 16-17 and Fig. 4-7 in the present application). Koyama does not cure the deficiency of JP '281.

In view of the foregoing, the obviousness rejection of claims 22-24, 33, 35-41, 69-75, 84, 86, and 90-91 is erroneous and should be withdrawn.

2. Claims 25-32, 76-83, and 87-89.

These claims are rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over JP '281 in view of Koyama as applied to claims 22-24, 33, 35-41, 69-75, 84, 86, and 90-91 above, and further in view of JP 03153778 or U.S. Patent 4,371,632 (Grossman et al.). Applicants respectfully traverse this rejection.

These claims are ultimately dependent upon independent claim 22 or 73. Therefore, the claims require that the erasable colored pencil lead composition is capable of forming a cohesive layer when applied to a surface. As discussed, JP '281 and Koyama fail to suggest to those of ordinary skill such a composition. JP '778 and Grossman et al. do not cure the deficiencies of JP '281 and Koyama. JP '281, Koyama, JP '778, and Grossman et al., either alone or in combination, fail to suggest to those of ordinary skill in the art the presently claimed invention.

In view of the foregoing, the obviousness rejection of claims 25-32, 76-83, and 87-89 is erroneous and should be withdrawn.

3. Claims 23-33, 36-39, 74-84, and 86-89.

These claims are rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Hoshiba et al. in view of JP 55025368, JP '281, Koyama, and either JP '778 or Grossman et al. Applicants respectfully traverse this rejection.

The above claims are ultimately dependent upon independent claim 22 or 73. Therefore, these claims require that the erasable lead composition is capable of forming a cohesive layer. As discussed, Hoshiba et al. fails to disclose or suggest to those of ordinary skill in the art the composition that forms the cohesive layer. The secondary references, JP '368, JP '281, Koyama, JP '778, and Grossman et al., fail to cure the deficiency of Hoshiba et al. The cited reference either alone or in combination, fail to suggest to those of ordinary skill in the art the presently claimed invention.

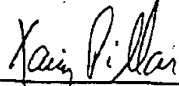
In view of the foregoing, the obviousness rejection of these claims is erroneous and should be withdrawn.

in re Appln. of LEIDNER et al.  
Application No. 09/828,219

Conclusion

The application is considered in good and proper form for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Xavier Pillai, Reg. No. 39,799  
LEYDIG, VOIT & MAYER  
700 Thirteenth Street, N.W., Suite 300  
Washington, DC 20005-3960  
(202) 737-6770 (telephone)  
(202) 737-6776 (facsimile)

Date: *January 3, 2003*



PATENT  
Attorney Docket No. 209391/B&S

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

LEIDNER et al.

Application No. 09/828,219

Art Unit: 1714

Filed: April 9, 2001

Examiner: Callie E. Shosho

For: ERASABLE COLORED PENCIL LEAD

**AMENDMENT TO ABSTRACT  
MADE IN RESPONSE TO OFFICE ACTION DATED JULY 5, 2002**

~~The present invention provides~~ Disclosed is an erasable colored pencil lead composition comprising, in an embodiment, a colorant, one or more binder resins, an antioxidant, a fibrillatable or fibrillated material, and a filler. ~~The~~ Also disclosed is a colored pencil lead composition of the present invention which produces marks on paper, which are easily erased by ordinary pencil eraser. The mark made using the composition has a cohesive nature that assists in the removal from paper in sheet or film like sections by the use of an ordinary pencil eraser without smearing or leaving a residue. In a preferred embodiment, the composition is free or substantially free of low melting waxes or ~~wax like~~ waxy materials. ~~Examples of suitable binder resins include high density polyethylene, low density polyethylene, polypropylene, and high melting waxes. Examples of fibrillated or fibrillatable materials include fibrillatable or fibrillated polytetrafluoroethylene and ethylene-vinyl acetate copolymer. The colored pencil lead composition may further include a lubricant. Examples of suitable lubricants include particulate lubricants such as micronized PTFE and non-particulate lubricants such as alkoxyated materials, e.g., polyethylene glycols. The present invention further provides~~ Also disclosed is a process method for using ~~the~~ a colored pencil lead composition. ~~The present invention further provides a process for preparing the colored pencil lead of the present invention.~~